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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,666	12/20/2000	Hiroyasu Yamamoto	Q62094	3947

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
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Washington, DC 20037

EXAMINER

LEE, CHEUKFAN

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/739,666	YAMAMOTO, HIROYASU	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cheukfan Lee	2627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 28, 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 15-21, 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 8-14 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Claims 1-14 and 22-24 are present for examination. Claims 15-21 have been withdrawn from consideration. Claims 23 and 24 are newly added, which correspond to non-elected Species II, Figs. 5-6C. **Claims 23 and 24 are therefore withdrawn from consideration.**

Only claims 1-14 and 22 are examined.

2. Applicant's arguments with regard to the rejection of claim 6 under 35 U.S.C. 112, second paragraph are convincing. The examiner misread the word "reserved". The 112, second paragraph rejection of claim 6 is withdrawn. Please Applicant's remarks on page 8, paragraph 4 filed July 28, 2005.

3. In the Species Election Requirement dated October 1, 2004, **claim 1 is stated as a generic claim.**

Please note that **claims 6 and 7 are also generic** to both species I corresponding to Figs. 1-4 and II corresponding to Figs. 5-6C and will be examined along with claims 1-14 and 22.

**Claims 1, 6 and 7, however, are improper generic claims. Rejection(s) and objection(s) to the claims follow.**

4. Claims 1, 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The claim 1 invention is **inconsistent** with the disclosure because of the claimed “an entry or exit side” and “in said first direction or in a second direction opposite to said first direction”.

Claim 1 recites “returning a forward end of said film to said read and transport path on an entry or exit side of said read and transport path after said first image reading has been finished” (hereinafter referred to as the first limitation), and “transporting said film along said read and transport path in said first direction or in a second direction opposite to said first direction to perform a second image reading in which the images in said plurality of frames are read by said image reading device at said image reading position in a sequence of frames that was applied to said first image reading” (hereinafter referred to as the second limitation). The disclosure describes two different, exclusive embodiments/species corresponding to Fig. 5 and Fig. 1, which means that the two embodiments/species cannot be mixed. Any of the two disclosed inventions/species does not provide an “or” option as claimed in the “an entry or an exit side” limitation and in the “in said first direction or in a second direction opposite to said first direction”. Claim 1, however, is written as if the first and second embodiment/species are combined to be a single embodiment/species that provides an option for either the entry side “or” the exit side and either the first direction “or” the second direction. There is no such combined embodiment/species found in the disclosure.

Further, because of the use of “or”, the claim interpretation allows “an entry or exit side” and “in said first direction or in a second direction opposite to said first

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direction" to be interpreted in four different combinations of limitations, and any one of the four combinations can be selected for the purpose of examination. The first combination is "an entry" and "a first direction", the second combination is "an entry" and "a second direction opposite to the first direction", the third is "an exit side" and "a first direction", and the fourth is "an exit side" and "a second direction opposite the first direction". The disclosure does not provide all four combinations.

Claims 6 and 7 each also claim returning the film to the path on "the entry or exit side" of the path, and therefore, are rejected for the reason given for claim 1 above with respect to "entry or exit side".

5. Claims 1, 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 is claiming an embodiment/species that does not exist in the specification, one which is produced by combining the one species shown in Fig. 5 and the other which is shown in Fig. 1. Claim 1 claims that the film is returned to the path on "an entry or exit side" of the path (lines 8-9 of claim 1) and that the film is transported along the path "in said first direction or in a second direction opposite to the first direction" (lines 10-11 of claim 1). Because of the use of the "or" limitation in the claim,

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the claimed invention provides an option to choose from "an entry side" or "an exit side" and an option to choose from "a first direction" or a "second direction opposite to the first direction". Such species or embodiment that provides such option was not described in the specification in such a way as to enable one skill in the art to make and/or use the invention.

Claims 6 and 7 each also claim returning the film to the path on "the entry or exit side" of the path, and therefore, are rejected for the reason given for claim 1 above with respect to "entry or exit side".

6. The following quotations of 37 C.F.R. § 1.75(d)(1) is the basis of objection:

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

7. Claims 1, 6 and 7 are objected to under 37 C.F.R. § 1.75 as failing to conform to the invention as set forth in the remainder of the specification.

Claim 1 does not conform to the two embodiment/species (corresponding to Figs. 5 and 1) set forth in the specification, which are exclusive to each other (Figs. 5

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and 1). There is lack of basis of the claimed invention in the specification because the claimed invention returns the film to the path on "an entry or exit side" of the path (lines 8-9 of claim 1) and transports the film along the path in "said first direction or in a second direction opposite to said first direction" (lines 10-11 of claim 1). The terms or phrases "an entry or exit side" and "in said first direction or in a second direction opposite to said first direction" do not have clear support or antecedent basis in the description of the disclosed invention.

Claims 6 and 7 each also claim returning the film to the path on "the entry or exit side" of the path, and therefore, are rejected for the reason given for claim 1 above with respect to "entry or exit side".

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jamzadeh et al. (U.S. Patent No. 5,504,583). The rejection stands. The rejection is repeated below.

Regarding claim 1, Jamzadeh et al. discloses an image reading method in which a filmstrip (F) (film) having images recorded on a plurality of frames (i3, i4, i5, ... in) in the longitudinal direction is transported to read the images in the frames at an image reading position by an image reading apparatus. A low resolution scan, i.e., a prescan, is performed on all frames of the film (F) first, and then a high resolution is performed on all the frames of the film (F).

The filmstrip (F) is transported in a first direction (designated with an arrow in Fig. 2) along a read and transport path including the image reading position to perform the prescan (first image reading) for reading the images on the plurality of frames by the image reading device, then, the film (F) is transported along the read and transport path in the first direction (the direction designated with the arrow in Fig. 2) to perform the high resolution scan (second image reading) in which the images in the plurality of frames of the film (F) are read by the image reading device in the same sequence of frames that was applied to the prescan (first image reading). Information obtained from the prescan include frame position of the plurality of frames, the type of film (F), the conditions of each image frame, etc.). These information are used for later use in subsequent scan and processing. See col. 6, lines 8-22, lines 46-55, col. 1, lines 35-55, and claim 3 at col. 7, lines 63-67.

With respect to the claimed step of returning a forward end of the film to the read and transport path on an entry or exit side of the read and transport path after the first image reading has finished, the limitation "an entry side" is selected in the "entry or exit side" limitation for the purpose of this rejection.



In Jamzadeh et al., the frames of the film (F) are scanned twice as explained above, i.e., a low resolution prescan and a high resolution scan. There is only one arrow showing one direction of the in which the film (F) is transported during both low-resolution prescan and the high resolution scan (Fig. 2). This means that in both scans, the same first frame of the film (F) is transported first in the read and transport path. Nowhere in the Jamzadeh et al. disclosure states that the images of the plurality of frames are stored and that the order of frames is altered after the prescan. Though Jamzadeh et al. does not explicitly disclose returning the film (F) in the first direction (arrow pointing direction), one of ordinary skill in the art would have understood that the frames of the film (F) are read in the same order by the image reading device for both the prescan and high resolution scan. It would have been obvious to one of ordinary skill in the art at the time the invention was made to return the forward end of the film (F) to the entry side of the read and transport path or Jamzadeh et al. so that the same first frame is read first in the high resolution scan in order to keep the positions of the frames the same.

Regarding claim 2, the prescan is at low resolution and the second scan is at high resolution as discussed above.

Regarding claims 3 and 4, see frame positions, reading conditions and processing conditions generated using the prescan low-resolution image data (col. 6, lines 8-22 and lines 46-55).

Regarding claim 5, the second scan of the film is a high resolution scan as discussed above.

10. In response to Applicant's arguments that the high resolution scan in Jamzadeh (5,504,583) need not be performed in the same order with that of the prescan (page 10, paragraph 2 of the remarks), as stated in the previous Office Action, the same figure (Fig. 2) showing one arrow is used to show the exemplary embodiment in which the prescan and the high resolution scan are performed. Even if Applicant's statement is correct that "the high resolution scan need not to be performed in the same order with that of the prescan", it does not mean that the possibility that high resolution scan is performed in the same order or at least the forward end of the film (F) is returned to the entry side of the read and transport path for a second and high resolution scan is totally eliminated in Jamzadeh. Thus, because of that and because Jamzadeh shows only one arrow designating the direction of film transport during transport, it would have been obvious to one of ordinary skill in the art at the time the invention was made to return the forward end of the film (F) to the entry side of the read and transport path of Jamzadeh et al. so that the film transport mechanism is controlled in the same sense (as in reversing the drive motor to drive the transport mechanism in a reversed direction) in order to simplify the film transport mechanism control system. Therefore, the rejection of claim 1 stands.

Claims 2-5 depend upon claim 1. The rejections for claims 2-5 addressed above stands for the reason given for claim 1.

11. Claims 8-14 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, provided that the base claim and the intervening claims are amended to overcome the 112 rejections and the objection set forth in this Office Action.

12. The following is an examiner's statement of reasons for allowance:

Claim 8 would be allowable because Jamzadeh et al. does not disclose a loop-shaped transport path so that the forwarding end of the film is returned to the read and transport path, in combination with other limitations of claims 7 and 1.

Claims 9-14 depend upon claim 8, directly or indirectly.

Claim 22 would be allowable because Jamzadeh et al. does not disclose correcting the conditions and performing the second image reading (high resolution scan) in parallel, in combination with other limitations of claims 22 and 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (currently known), can be reached on (currently unknown). The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee  
October 20, 2005

Handwritten signature of Cheukfan Lee in cursive script.